

V. REMARKS

Claims 1-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of Yasufuku et al. (U.S. Patent No. 6,264,506). The rejection is respectfully traversed.

Double patenting is concerned with attempts to "claim" related subject matter twice. In determining double patenting, the issue is whether any claim of the application defines merely an obvious variation of an invention claimed in the earlier patent or application. It does not prohibit a later claiming of subject matter that is disclosed but not claimed in the earlier patent. The United States Patent and Trademark Office must establish a *prima facie* case of obviousness-type double-patenting or the rejection, if applied, will be reversed by the Board of Patent Appeals.

The issue in addressing the judicially created doctrine of obviousness-type double patenting is whether any claim of the application defines merely an obvious variation of the invention claimed in the earlier patent.

Claim 1 of the 506 patent is directed to a card connection adapter for connecting a card slot to a card by fitting the card in the card slot and includes a first connector, a second connector and a card-shaped housing which holds the first connector and the second connector. Claim 1 of the 506 patent recites that the housing has a first cover that covers a frame, a card retaining space defined in the housing for retaining therein the card and a card insertion port provided on one end face thereof and communicating with the card retaining space. Claim 1 of the 506 patent also recites that the first cover formed with a cut-away portion is recessed from the card insertion port end face in a card insertion direction with the cut away portion having a greater width than the card.

Claim 3 of the 506 patent recites that the frame holds signal conversion circuitry for mutual signal conversion between the first standard and the second standard between the card retaining space and the second cover.

In contrast, claim 1 of the present invention recites a card connection adaptor for connecting to a connector of a card slot compliant with a predetermined first standard a card compliant with a second standard which is different from the first standard. Claim 1 of the present invention recites that the card connection adaptor includes a first connector, a second connector, signal conversion circuitry and a housing. Claim 1 of the present invention recites that the first connector is compliant

with the first standard and is adapted to be electrically connected to the connector of the card slot. Claim 1 of the present invention also recites that the second connector is compliant with the second standard and the signal conversion circuitry is connected to the first connector and the second connector for performing signal conversion between a first-standard-compliant signal and a second-standard-compliant signal. Additionally, claim 1 of the present invention recites that the housing holds the first connector, the second connector and the signal conversion circuitry and has a card insertion port which opens generally perpendicularly to an adaptor insertion direction in which the card connection adaptor is inserted into the card slot and a card retaining space for retaining therein the second-standard-compliant card inserted from the card insertion port.

It is respectfully submitted that the features of claim 1 of the present invention are not taught or suggested in claims 1 and 3 of the 506 patent. Specifically, it is respectfully submitted that claims 1 and 3 of the 506 patent fail to teach or suggest a housing having a card insertion port which opens generally perpendicularly to an adaptor insertion direction in which a card connection adaptor is inserted into a card slot and a card retaining space for retaining therein a second-standard-compliant card inserted from the card insertion port. Thus, it is respectfully submitted that one of ordinary skill in the art would not be motivated to modify the features of claims 1 and 3 of the 506 patent because such features are devoid in these claims. As a result, it is respectfully submitted that claim 1 of the present invention would therefore not be considered obvious in view of the applied claims and would be allowable over the applied art.

Claims 2-15 depend from claim 1 and include all of the features of claim 1. Thus, it is respectfully submitted that the dependent claims are allowable at least for the reason claim 1 is allowable as well as for the features they recite.

Furthermore, the United States Patent and Trademark Office is obligated to clearly set forth the basis of an obviousness-type double-patenting rejection. Under MPEP 804 II. B. 1., it states:

Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined in the conflicting claims—a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

It is respectfully submitted that the rejection is also improper because the United States Patent and Trademark Office fails to make clear the obviousness-type double patenting rejection, particularly as required under subparagraphs (A) and (B) of MPEP 804 II. B. 1. As a result, it is respectfully submitted that the United States Patent and Trademark Office fails to establish a *prima facie* case of obviousness-type double patenting.

Withdrawal of the rejection is respectfully requested.

In view of the foregoing, reconsideration of the application and allowance of the pending claims are respectfully requested. Should the Examiner believe anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' representative at the telephone number listed below.

Should additional fees be necessary in connection with the filing of this paper or if a Petition for Extension of Time is required for timely acceptance of the same, the Commissioner is hereby authorized to charge Deposit Account No. 18-0013 for any such fees and Applicant(s) hereby petition for such extension of time.

Respectfully submitted,

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